

Remarks

Applicants appreciate the thorough examination of the present application as evidenced by the Office Action dated March 25, 2004 ("Office Action"). Claims 7-16 and 21 are pending in the present application upon entry of the present Amendment. Claims 7-12 have been withdrawn from consideration. Claims 13, 15 and 16 have been amended herein. Applicants submit concurrently herewith a Statement In Support of Filing A Sequence Listing Under 37 C.F.R. § 1.821(f) and a Substitute Sequence Listing in paper and computer-readable format. Support for the amendments to the specification and the claims can be found in the specification and claims as originally filed and as discussed further below. Applicants respectfully submit that these amendments do not present new matter, and respectfully request entry thereof.

The concerns raised by the Examiner in the Office Action are addressed below.

I. Interview Summary

On July 29, 2004, Applicants' representative, Shawna Cannon Lemon, participated in a telephonic interview with Examiner Schultz to discuss the status of the present application. The Examiner indicated that he and his supervisor recommend the incorporation of sequence identifiers in the specification and claims for EMAP II in order to place the application in condition for allowance. The Examiner specifically suggested focusing on U.S. Patent No. 5,641,867 to Stern et al., the disclosure of which was incorporated by Applicants into the present application in its entirety. The current Amendment presents the amendments recommended by the Examiner to place the application in condition allowance. Accordingly, Applicants respectfully request entry of this Amendment and allowance of the application.

II. Specification

Applicants have amended the specification as presented above to denote the relationship between applications as indicated in the Office Action on page 2.

III. Election/Restrictions

Applicants appreciate the Examiner's reconsideration of the Election/Restriction Requirement. Applicants acknowledge that in view of the Examiner's consideration of the Election Restriction Requirement, claims 7-12 stand withdrawn from consideration.

IV. Claim Objections

Applicants have amended withdrawn claim 10 pursuant to the Examiner's suggestion. Accordingly, Applicants respectfully request that this objection be withdrawn.

V. Claim Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph as allegedly failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicants have amended claim 13 pursuant to the Examiner's suggestion. Accordingly, Applicants respectfully request that this rejection be withdrawn.

VI. Claim Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 13-16 and 21 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. More specifically, the Office Action states that "the rejected claims do not recite any sequence identifier. The gene is thus considered to be defined and claimed by its function (i.e. that which is EMAPII-like) rather than by any specific or particular structure(s)." Office Action, page 4. The Office Action further states that "[t]he specification refers to an EMAP II isoform as taught by Stern (U.S. Patent Number 5,641,867), and appears to incorporate the disclosure of Stern by reference at page 6 line 25. However, no other EMAP II isoform of any other type is referenced in the specification, and the prior art does not appear to teach any further EMAP. Furthermore, applicants specification does not recite the actual sequence of the EMAP II as taught by another person and not disclosed herein is not considered to meet the requirements for disclosure of a representative sample of structures that correlate to the genus of any molecule encompassing any EMAP II activity, such that one of skill would consider applicants to be in possession of said genus." Office Action, page 5.

In order to expedite prosecution, Applicants have amended the specification as noted above to include sequence identifiers and a substitute sequence listing. Claims 13, 15 and 16 have been amended to recite sequence identifiers. Support for these amendments can be found in U.S. Patent No. 5,641,867 to Stern et al. (Stern et al.). Applicants incorporated the disclosure of Stern et al. by reference in its entirety as indicated in the present application on page 6, lines 23-26. Thus, Applicants respectfully submit that no new matter is added by these amendments to the specification and claims.

Accordingly, Applicants respectfully submit that claims 13-16 and 21 comply with the written description requirement under 35 U.S.C. § 112, first paragraph, and respectfully request that this rejection be withdrawn.

VII. Terminal Disclaimer

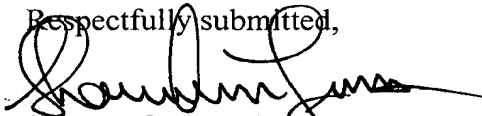
Based upon a teleconference on March 30, 2004 with Examiner Schultz, it is the undersigned's belief that the Examiner indicated that the present application would be allowable if, in addition to the Examiner's proposed amendments, Applicants filed a terminal disclaimer over prior U.S. Patent No. 6,306,612, issued October 23, 2001 (the parent application). Responsive to the Examiner's indication, Applicants submitted a terminal disclaimer to disclaim the terminal part of any patent granted on the present application. As these actions did not result in allowance of the present application, Applicants respectfully request that the Examiner indicate whether a terminal disclaimer remains necessary to procure allowance of the present application in view of the amendments to the specification and claims presented herein.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request allowance of all the pending claims and passing this application to issue.

The Examiner is invited and encouraged to contact the undersigned directly if such contact will expedite the prosecution of the pending claims to issue. In any event, any questions that the Examiner may have should be directed to the undersigned, who may be reached at (919) 854-1400.

Respectfully submitted,

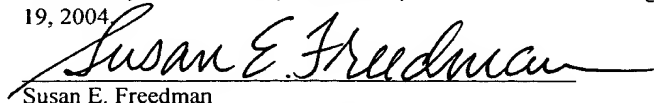


Shawna Cannon Lemon
Registration No. 53,888

USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec, P.A.
P. O. Box 37428, Raleigh, NC 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on August 19, 2004.



Susan E. Freedman
Date of Signature: August 19, 2004